



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,953	03/28/2001	Paul Alan Stirpe	003433.00003	9620
22907 7590 07/16/2009 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051				
EXAMINER				
CASLER, TRACI				
ART UNIT		PAPER NUMBER		
3629				
MAIL DATE		DELIVERY MODE		
07/16/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/818,953

Applicant(s)

STIRPE ET AL.

Examiner

Traci L. Casler

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 6-17, 20-30, 32-39, 42-46, 48-51, 53-56 and 60-73 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 2-4, 6-17, 20-30, 32-39, 42-46, 48-51, 53-56 and 60-73 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

This action is response to papers filed on April 13, 2009.

Claims 15-17, 20-30, 34, 39, 42, 48, 55 and 62 have been amended.

Claims 2-4, 6-17, 20-30, 34, 32-39, 42-46, 48-51, 53-56 and 60-73 are pending.

Claims 2-4, 6-17, 20-30, 34, 32-39, 42-46, 48-51, 53-56 and 60-73 are rejected.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

2. As to claims 20-25 in order for a method/process claim to fall within statutory subject matter the claims be tied to either a machine or transformation. A two-branched inquiry is used to show that a claim is statutory by either tying it to a particular machine or a by showing that the claim transforms an article. The use of a specific machine or transformation of an article must impose "**meaningful limits**" on the claims' scope to impart patent-eligibility. The involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity, such as storing, gathering, displaying, sending and receiving of data as this does not impart a significant impact in the solution to the process but be clearly and positively claimed as to what aspect of the problem solving the machine is involved. See in re Bilski.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 2-4, 6-17, 20-23, 25-31, 32-39, 42-46, 48-51, 53, 55-56, 60-67 and 68-73 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,151,584 Papierniak et al; Computer Architecture and Method for Validating and Collecting and metadata and data about the internet and electronic commerce environments (data Discovery). Hereinafter referred to as Papierniak. in view of US Patent 6317722, Jacobi et al; Use of electronic Shopping Carts to Generate personal recommendations. Hereinafter referred to as Jacobi.

6. As to claims 25, 34, 42, 48, 55 system and method providing personalized content to a user comprising of storage, categorizing and grouped according to relatedness and analysis of data. *Papierniak et al. Discloses a method of capture with enhanced analysis techniques to exploit vast information through uses of the web...results allow better (statistical) decisions. (C.3 I. 20-25) as well as the inter-relationship characterization of data(C. 16 I. 35-40)(one to one; one to many etc).* Papierniak fails to teach "each weighted second node corresponding to one of the first nodes of ontology, each weighted second node indicating a degree to which the user is interested in the concept of the corresponding first node of ontology. ***Wherein at least one particular weighted second node is generated dependent on another particular weighted second node being generate*** However, Jacobi teaches weighting a known item of interest corresponding to similar items on the list and how they are weighted.(C. 6 I. 40-50 and C. 11 I. 25-38). Jacobi weights "similar items list" based on the corresponding rating given by the user. It would have been obvious to one skilled in the art at the time of invention to combine the known technique of weighting user interest against similar items to known method ready for improvement to yield predictable results.
7. As to claims 2-4, *the data in the warehouse...usually subject-oriented such as customer, product, activity. (C. 14 I. 55-58)*
8. As to claims 28 and 37 *formatted file library provides the intermediate classifications such as process characterizations, customer preferences, preference determination and behavior patterns. (C. 18 I. 45-48)*

As to claims 6, 32-33, 43, 49 and 56, *websmart is intend to provide the best possible knowledge for customers.* (C.18 l. 6-7)

9. As to claims 7, 9-10, 26-27 an d35-36 *a display for displaying information to a computer user.* (C. 10 l. 45-46, Fig. 4 Ref. 12)

10. As to claim 8 *involves parsing, categorizing, indexing and formatting the collected data and classifications based on preference determination used in a the technical process.* (C. 13 l. 17-18 and C. 18 l. 47-50)

11. As to claims 11, 29 and 38 *to collect data which indicates where a user has been in prior sessions.* (C. 2 l. 65-66)

12. As to claim 12, *Source data* (Sheet 13 Fig. 13, bottom left corner)

13. As to claim 13 *visitor profile data...depends on how much information the visited applications can entice the visitor to provide.* (C. 15l. 47-49)

14. As to claim 14, *data mining tools enable the present invention to discover hidden knowledge from existing data and information.* (18 l, 65-67)

15. As to claim 15, *wherein the multiple client browsers or clients are capable of accessing a server or web server storing information.* (C.26 l.49-50)

16. As to claims 16 and 17 *results used by user for decisions*(C. 3 l. 24-27) *and results given to businesses about their customers to gain insight.*(C. 3l. 36-40). The applicant is reminded that system claims are direct to the "structure" not what the structure does or the steps it performs. Additionally the applicant is reminded. Claim scope is not limited by claim language that suggests or makes optional but does not

17. require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

18. (A) "adapted to" or "adapted for" clauses;

19. (B) "wherein" clauses; and

20. (C) "whereby" clauses.

21. The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited."

22. As to claim 20 *providing customers with recommendations from information that was analyzed in clustering or artificial intelligence.* (C. 13 l. 27-29)

23. As to claims 30, 39, 50 and 53, *web warehouse is preferably time-stamped and associated with a defined period...subject oriented such as customer, product, activity and characterizing resources based on different criteria.* (C14. 56-61 and C. 16 l.35-45)

24. As to claims 21-23 *metadata defines the data views necessary to produce the outputs required for decision support.* (C. 15 l. 54-56)

25. As to claims 44-46, as best understood by the examiner, *deletion of data in the web warehouse in an appropriate time.* (C. 15 I. 65-67)

26. As to claims 60-61 Papierniak teaches *a display for displaying information to a computer user.* (C. 10 I. 45-46, Fig. 4 Ref. 12). Although Papierniak does not explicitly teach they information displayed as articles and advertisement these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps would be performed regardless of the type of information presented. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 44(Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir.

27. As to claims 62 a system and method providing personalized content to a user comprising of storage, categorizing and grouped according to relatedness and analysis of data. *Papierniak et al. Discloses a method of capture with enhanced analysis techniques to exploit vast information through uses of the web...results allow better (statistical) decisions.* (C.3 I. 20-25) , *websmart is intend to provide the best possible knowledge for customers.* (C.18 I. 6-7) *a display for displaying information to a computer user.* (C. 10 I. 45-46, Fig. 4 Ref. 12) *involves parsing, categorizing, indexing and formatting the collected data.* (C. 13 I. 17-18)
Papierniak teaches a method of "incremental" data sources responsive to the decision support.(C23 I.62-65) as well as the inter-relationship characterization of data(C. 16 I. 35-40)

28. As to claims 63-67 *identifies many relationships and different levels of relationships between data.*(C. 16 l. 34-40 and Fig. 15-Fig. 16)

29. As to claims 68-73 Papiernaik teaches extracted data is refined and translated before correlating it with operational data. (C. 4 l. 53-55). Papiernaik tags to data as according to the business context but gives it no weighting.

Claim Rejections - 35 USC § 103

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. Claims 24, 51, 54 rejected under 35 U.S.C. 103(a) as being unpatentable over Papierniak et al and Jacobi et al as applied to above, and further in view of Financialengines.com(any linkage Oct. 12, 1999).

32. As to Claim 24, Papierniak and Smith fail to teach a display method for the of what the gathered information means. Financialengines.com teaches ***how your decisions and advisor fund recommendations affect your future.***(P. 7 l. 4-7) See also Pg. 6 Fig. 2. It would have been obvious to one skilled in the art to incorporate the display method of financialengines.com to allow to the customer to see where they fit into the financial picture.

33. As to claims 51 and 54 Papierniak and Smith fail to teach comparison method, financialengines.com teaches a ***retirement income projection is compared to your goal on a scenario by scenario basis***. (Pg. 17 l.6-7) It would have been obvious to one skilled in the art to incorporate the teachings of comparison into Papierniak so as to allow the customer the ability to make an accurate decision of one product over another.

Response to Arguments

34. Applicant's arguments filed April 13, 2009 have been fully considered but they are not persuasive.

35. Applicant argues that Papierniak/Jacobi fail to teach "weighting nodes" based on another weighted node. However, examiner noted in the rejection that Jacobi teaches weighting the similar items list based on the users rating(1-5) of the corresponding item. Therefore as applicant has pointed out that weighting can be considered users "explicit" rating of interest this reads on the claim limitations.

36. Applicant's arguments, see Pg. 1 , filed April 13, 2009, with respect to 35 USC 112 1st rejection have been fully considered and are persuasive. The rejection under 35 USC 112 1st has been withdrawn.

Conclusion

37. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Traci L Casler/
Examiner, Art Unit 3629

/JOHN G. WEISS/
Supervisory Patent Examiner, Art Unit 3629